

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

851963.425USPC

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on \_\_\_\_\_

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name \_\_\_\_\_

Application Number

10/583,577

Filed

July 2, 2007

First Named Inventor

Andrew Dellow

Art Unit

2431

Examiner

Shin-Hon Chen

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/Timothy L. Boller/

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

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Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

February 11, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☒ \*Total of 1 forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Andrew Dellow et al.  
 Application No. : 10/583,577  
 Filed : July 2, 2007  
 For : MONOLITHIC SEMICONDUCTOR INTEGRATED CIRCUIT  
 AND METHOD FOR SELECTIVE MEMORY ENCRYPTION  
 AND DECRYPTION

Examiner : Shin-Hon Chen  
 Art Unit : 2431  
 Docket No. : 851963.425USPC  
 Date : February 11, 2010

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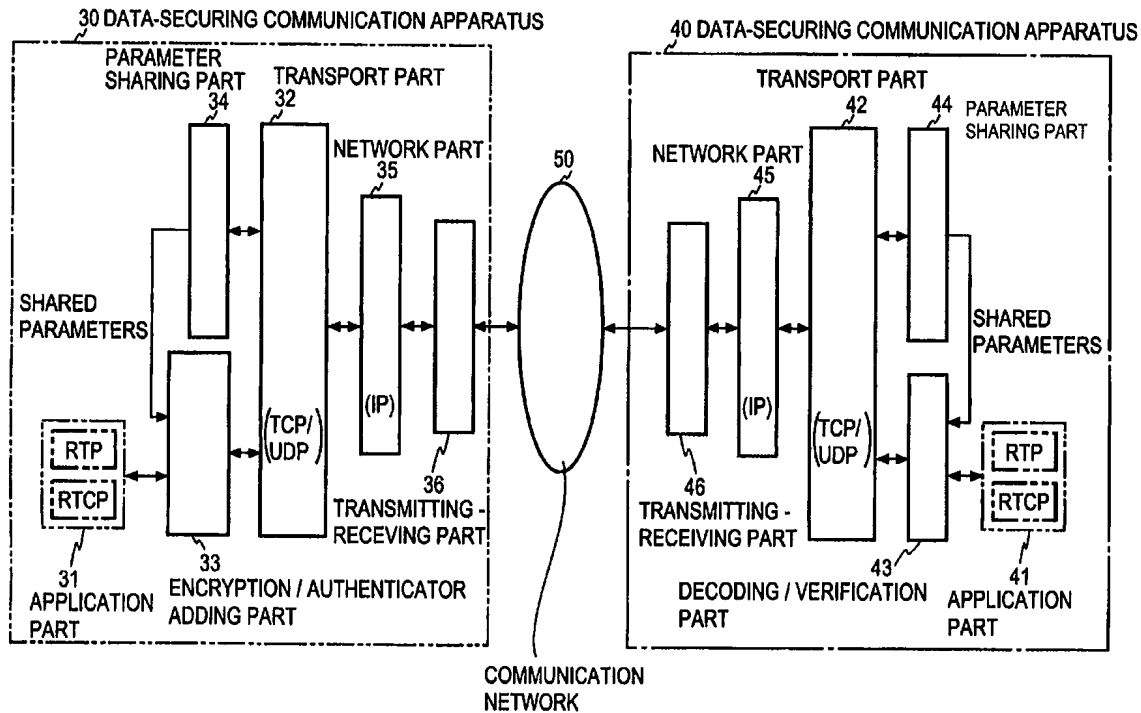
PRE-APPEAL BRIEF REQUEST FOR REVIEW REMARKS

This request for pre-appeal review is in response to the Final Office Action mailed November 10, 2009. The Examiner rejected claims 1-36 under 35 USC 103(a) as obvious over U.S. Patent No. 7,216,230 issued to Suzuki, et al., without citing a secondary reference. The claims are not rendered obvious by Suzuki because each of the independent claims recites multiple elements that are not disclosed or otherwise rendered obvious by Suzuki.

The Examiner bears the burden of establishing a *prima facie* case of unpatentability. *See, e.g., In re Bell*, 26 U.S.P.Q.2d 1529 (Fed. Cir. 1993); MPEP § 2142. In order to find *prima facie* obviousness, MPEP § 706.02(j) states (emphasis ours): “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 USPQ 972,

973 (Bd. Pat. App. & Inter. 1985).” Suzuki is not an appropriate single reference for rendering the claims obvious because multiple elements of each of the independent claims are not found in Suzuki, and the Examiner has not presented a convincing line of reasoning for why one of skill in the art would find the modifications that would be required to Suzuki to be obvious.

The Examiner relies primarily on Column 6, lines 14-45 of Suzuki, which describe Figures 9 and 10 of Suzuki in the apparent context of Figure 7 of Suzuki. For convenience, Figure 7 and Column 6, lines 14-45 of Suzuki are set forth below.



As depicted in Figure 10, when it is decided in step S2 that the encryption/authentication parameters are not for RTP packet selective encryption, the parameter sharing part 44 of the communication apparatus 40: decides whether the input data (application) from the application part 41 of the communication apparatus 40 is an RTP packet (S5); if it is an RTP packet, makes a check to see if the communication network 50 to which the communication apparatus 40 is connected is, for example, a mobile communication network of low transmission rate (S6); and if so, goes to step Se, in which it determines the encryption/authentication parameters indicating RTP packet selective encryption and sends it to the communication apparatus 30 (S4). When it is decided in step S5 that the input data is not an RTP packet, or when it is decided in step S6 that the communication network 50 is not a mobile communication network whose transmission rate is not low, the parameter sharing part determines encryption/authentication parameters indicating non-selective encryption (S7), and sends the parameters to the communication apparatus 30 (S4).

As depicted in Figure 9, upon receiving the encryption/authentication parameters from the communication apparatus 40 (S8) after the transmission in step S7, the parameter sharing part 34 of the communication apparatus 30: makes a check to see if the received encryption/authentication parameters are those for RTP packet selective encryption (S9); if so, goes to step S6, in which the parameter sharing part determines the encryption/authentication parameters as those for RTP packet selective encryption; and if not for RTP packet selective encryption, determines the encryption/authentication parameters as those for non-selective encryption (S10).

Thus, the cited portions of Suzuki appear to be directed to selectively encrypting based on the type of data packet received from an application part and the transmission speed of a packet received from a remote device.

Turning to the language of the claims, independent claims 1 and 29 recite, “[a] monolithic semiconductor integrated circuit [comprising] a plurality of devices each having a unique identifier; ... a plurality of selectable data routes ... along which data may flow between the devices and [an] external memory, wherein at least one data route passes through the cryptographic circuit and at least one data route does not pass through the cryptographic circuit; and a control arranged to receive the unique identifier of a selected one of the devices transferring data, and to select one of the at least one data route ... according to the unique identifier of the selected device.” There is no mention in the cited portions of Suzuki and nothing in Figures 7, 9 or 10 of Suzuki showing a monolithic semiconductor integrated circuit having a plurality of devices each with a unique identifier, or of multiple data routes between the plurality of devices and an external memory. The Examiner provides no discussion of how the recited elements of the claims correspond to elements disclosed in Suzuki. Assuming, *arguendo*, one of the data securing apparatuses 30, 40 of Figure 7 corresponds to the external memory and the other to the claimed monolithic semiconductor integrated circuit, and also assuming, *arguendo*, the parts of a respective apparatus correspond to the claimed devices, there is no indication that a plurality of parts of one of the apparatuses 30, 40 (for example, the parts 31, 33, 34, 32, 35, and 36 of apparatus 30), have unique identifiers or of a plurality of selectable data paths between the parts of one apparatus and the other apparatus. In Suzuki, there appears to be only one data path from a respective part of an apparatus to the other apparatus (e.g., from application part 31 of apparatus 30 to transmitting/receiving part 36 through the encryption/

authentication adding part 33, transport part 32, and networking part 35). There is no discussion or illustration in Suzuki of a data route from application part 31 that does not pass through encryption/authentication adding part 33. These missing elements alone demonstrate the Examiner has not met the burden of establishing a *prima facie* case of obviousness. Moreover, the Examiner concedes Suzuki does not disclose the recited “control arranged to receive the unique identifier of a selected one of the devices transferring data, and to select one of the at least one data route ... according to the unique identifier of the selected device.” The Examiner argues that because Suzuki discusses using encryption parameters and networking parameters to determine whether selective encryption is applied, all of the elements of claim 1 that are missing from Suzuki as discussed above are somehow rendered obvious to one of skill in the art. The Examiner has simply made a conclusory (and incorrect) statement. The Examiner has not presented “a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious” as required. Accordingly, the Examiner has failed to present a *prima facie* case that claims 1 and 29 are anticipated or rendered obvious by Suzuki, and thus claims 1 and 29 are allowable.

Independent claim 16 recites, “[a] method, comprising: transmitting data between one of a plurality of devices, the devices each having a unique identifier, and an external memory, the data being transmitted along one of a plurality of selectable data routes formed from a plurality of data pathways, ... selecting a data route of the at least one data route that passes through the cryptographic circuit, or one of the at least one data route that does not pass through the cryptographic circuit, according to the unique identifier of the selected device.” The Examiner points to the same portions of Suzuki relied upon to reject claim 1 and does not tie specific claim language to specific disclosures in Suzuki. The Examiner does not identify the “plurality of devices each having a unique identifier,” or “the plurality of selectable data routes,” and appears to concede that the “selecting a data route ... according to the unique identifier of the selected device” is not disclosed by Suzuki. For reasons that will be apparent in view of the discussion of claim 1 above, the Examiner has failed to make a *prima facie* showing of obviousness. Thus, claim 16 is not rendered obvious by Suzuki and is allowable.

In the Response to Arguments on pages 6 and 7 of the Final Office Action, the Examiner appears to reason that the claimed combinations are not patentable because some of the recited features would not be separately patentable. The claims, however, do not merely recite “selectively processing/encrypting data packets over a communication network, where a plurality of nodes exists based on unique identifiers,” or merely shrinking such a communication system to a semiconductor device, as the Examiner suggests. The Examiner continues to ignore limitations in the claims such as, for example, “at least one data route passes through the cryptographic circuit and at least one data route does not pass through the cryptographic circuit ... a control arranged to select one of the at least one data route ... according to the unique identifier of the selected device,” in claims 1 and 29 and “selecting a data route of the at least one data route that passes through the cryptographic circuit, or one of the at least one data route that does not pass through the cryptographic circuit, according to the unique identifier of the selected device,” in claim 16. Accordingly, the Examiner is not applying the correct test and has failed to present a *prima facie* case of obviousness.

For at least the forgoing reasons, independent claims 1, 16, and 29 are allowable in view of the Suzuki. In addition, the dependent claims are allowable at least by virtue of their dependencies, as well as because of the novel and non-obvious combinations recited therein. Thus, the rejection of claims 1-36 cannot be sustained.

Respectfully submitted,

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